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IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
1650 MARKET ST
SUITE 4900
PHILADELPHIA, PA 19103

EXAMINER

RINES, ROBERT D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,172	Applicant(s) PUNZAK ET AL.	
	Examiner Robert D. Rines	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the application filed on 15 October 2003. Claims 1-32 are pending.

Claim Objections

[2] Claim 19 is objected to because a claim, which depends from a dependent claim, should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. Appropriate correction is required. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[3] Claims 13, 15, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite because there is a lack of antecedent basis for the phrase "at least one patient answer" as written in claims 13 and 15 and the phrase "said at least one patient answer" as written in claim 19. Examiner suggests a change in claim 13 to "the at least one patient's answer" or to "storing the, at least one patient, answer" or similar phrase introducing the patient's response to

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the questionnaire. Such a change would provide sufficient antecedent basis for the claims 13 and 19 as written.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

[4] Claims 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of:

(1) whether the invention produces a useful, concrete, and tangible result.

[5] For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claim 22, the act of "allowing" recited in the claim does not represent a positive step towards a useful, concrete and tangible result. The acts of "allowing" someone to engage in the activity of using technology does not actively produce a useful concrete and tangible result and therefore, claim 22 is rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

Claims 23-25 when analyzed in the same manner described above, also fail to produce a useful, concrete, and tangible result, and are therefore rejected, as well.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[6] Claims 1-5, 9-11, 13-15, 18, 20, 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Snowden et al., (United States Patent Application Publication US 2002/0026332).

[A] As per independent claim 1, Snowden et al., discloses a method for sharing medical information over a network comprising the steps of: allowing at least one medical patient to store medical history information in a computer database coupled to said network (Snowden et al.; pg. 3, paragraph [0080], pg. 5, paragraph [0111], paragraph [0112], and Fig. 2); and, one or more selected from the group consisting of: allowing said at least one medical patient to designate that only at least one said medical patient may have access to said medical history information from a computer coupled to said network (Snowden et al.; Abstract, pg. 5, paragraph [0105], and paragraph [0106]), and allowing said at least one medical patient to designate at least one medical professional that may have access to said medical history information from a computer coupled to said network (Snowden et al.; Abstract, pg. 4, paragraph [0102] and pg. 6, paragraph [0115]).

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[B] As per dependent claim 2, Snowden discloses the storage of medical history information comprising personal information, basic medical information and specialty medical information (Snowden et al.; paragraphs [0111], [0113], [0115]).

[C] As per dependent claim 3, Snowden et al., discloses allowing the at least one medical patient to modify said medical history information from any computer connected to the network (Snowden et al.; paragraphs [0105], [0113]).

[D] As per dependent claim 4, Snowden et al., discloses allowing the at least one medical professional to add additional information to said medical history information from any computer connected to the network, if the at least one medical patient has granted the at least one medical professional access to said medical history information (Snowden et al.; paragraphs [0113], [0115]).

[E] As per dependent claim 5, Snowden discloses designating at least one medical professional that may have access to said medical history information from a computer coupled to said network by entering a unique code corresponding to said at least one medical professional into said computer (Snowden et al.; paragraphs [0106], [0107]).

[F] As per dependent claim 9, Snowden discloses wherein said at least one medical professional comprises a physician (Snowden et al.; paragraph [0113]).

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[G] As per dependent claim 10, Snowden discloses wherein said at least one medical professional comprises administrative personnel (Snowden et al.; paragraphs [0105], [0111], [0112]).

[H] As per dependent claim 11, Snowden discloses wherein said at least one medical professional comprises a nurse (Snowden et al.; pg. 5, paragraph [0109] and pg. 6, paragraph [0115]).

[I] As per dependent claim 13, Snowden et al., discloses wherein said step of allowing at least one medical patient to store medical history information in a computer database coupled to said network comprises: presenting the at least one medical patient at least one questionnaire over the network; and storing the at least one patient answer to the at least one questionnaire in said computer database (Snowden et al.; paragraph [120]).

[J] As per dependent claim 14, Snowden et al., discloses comprising the further step of: permitting the at least one medical patient to select a type of medical visit (Snowden et al.; paragraph [0079]).

[K] As per dependent claim 15, Snowden et al., discloses comprising the further step of: presenting the at least one medical patient at least one questionnaire related to the type of medical visit over the network; and storing the at least one medical patient answer to the at least one questionnaire in said computer database (Snowden et al.; paragraphs [0079], [0120]).

[L] As per dependent claim 18, Snowden et al., discloses comprising the further step of: tracking computer access to said medical history information over said network (Snowden et al.; paragraphs [0106], [0107], [0119]).

[M] As per dependent claim 20, Snowden et al., makes no mention of requiring the at least one medical patient for a fee for the privilege of storing said medical history information.

[N] As per independent claim 28, Snowden et al., discloses a method for sharing medical information over a network comprising the steps of: allowing at least one medical patient to store medical history information in a computer database coupled to said network (Snowden et al.; pg. 3, paragraphs [0080], [0111], [0112] and Fig. 2); and, providing at least one medical professional the ability to view said medical history information from a computer coupled to said network (Snowden et al.; Abstract, paragraphs [0102], [0115]).

[O] As per dependent claim 29, Snowden et al., discloses the further step of: permitting the at least one medical patient to grant access to said medical history information to the at least one medical professional over said network, wherein said step of providing at least one medical professional the ability to view said medical history information is not permitted until the at least one medical patient has granted access to said medical history information to the at least one medical professional (Snowden et al.; Abstract, pg. 4, paragraphs [0102], [0115]).

[P] As per dependent claim 30, Snowden et al., teaches the further step of:
permitting the at least one medical patient to enter first specialty specific information relating to
a first specialty area (Snowden et al., paragraphs [0079], [0080]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al.

[A] As per claims 24-27, Snowden, as applied to claim 1 above, teaches the functions of claims 24-27, but does not explicitly state the use of a computer readable medium and code segments or computer readable media to enable the functions or to transmit data in a computer data signal embodied in a carrier wave.

However, Snowden teaches a system that comprises a network of computers, related equipment and applications software that uses the Internet and other advanced technologies to build,

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maintain, and link the consumer's medical record (Snowden et al.; paragraphs [0129], [0077]).

The examiner interprets Snowden's teaching of the use of networked computers and related equipment and applications software to mean that Snowden is using code and computer readable media to accomplish the functions of storing, retrieving, and securing data stored in the database. The examiner further interprets Snowden's function of "linking" the networked computers using "applications software" to encompass the applicant's transmission of code segments in the form of a computer data signal embodied in a carrier wave.

It would have been obvious to one of ordinary skill in the art at the time of invention to use the appropriate applications software to enable the functions of storing, retrieving, maintaining/modifying, securing, and linking data, as taught by Snowden referenced above. The motivation would have been to provide an electronic medical records system that employs a "best in class" hardware/software strategy of networked computers/servers to enable patients to build, maintain, update, secure and link a consumer's electronic medical record (Snowden et al.; [0077], [0129]).

[8] Claims 6-8, 12, 19, 22, 23, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al., as applied above, in view of Schoenberg (United States Patent # 6,463,417).

[A] As per claims 6-8 and 12, Snowden discloses designating at least one medical professional that may have access to said medical history information from a computer coupled

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to said network by entering a unique code corresponding to said at least one medical professional into said computer discloses wherein a one set of digits of said unique code designate a unique physician (Snowden et al.; paragraphs [0106], [0107]). Snowden does not teach the use of one set of digits of a unique code designating a unique physician (claim 6), or the use of another set of digits of said unique code designate a unique physician office (claim 7), or employing the unique code to permit precise routing of said medical history information to a specific physician office or offices (claim 8). Further, Snowden does not teach limiting a medical professional's access to said medical history information to pre-defined levels of access commensurate with said at least one medical professional's title (claim 12).

However, Schoenberg teaches the use of one set of digits of a unique, patient generated code and/or codes designating a unique physician (Schoenberg; Abstract and col. 2, lines 24-40 and col. 3, lines 1-20, and col. 5, lines 25-31). Schoenberg further teaches the use of a set of digits of said unique code designate a unique physician office and the use of codes permitting the routing of medical history information to a specific physician and/or physician's office (Schoenberg; col. 2, lines 40-62). Lastly, Schoenberg teaches limiting a medical professional's access to said medical history information to pre-defined levels of access commensurate with said at least one medical professional's title (Schoenberg; col. 2, lines 63-67, and col.3, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Snowden with the patient generated code teachings of Schoenberg. Such a configuration would enable the patient to generate a plurality of codes to designate access to a

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unique physician, physician's office, and indicate the routing of medical information to the requesting party from the database. The motivation would have been to provide an electronic medical records system that would allow the patient to require the identification of and level of access granted to a physician requesting medical information from the stored data, based on the code entered by the physician (Schoenberg; col. 3, lines 11-19, and col. 5, lines 25-32).

[B] As per claims 19 and 32, Snowden et al., teaches soliciting at least one medical patient to enter initial medical information into a database but does not specifically teach analyzing the entered medical information; and, customizing additional inquiries regarding medical information based on the initial medical information entered nor does Snowden teach the requirement of the patient answering at least one question when the patient requests access to the database.

However, Schoenberg does teach the step of allowing at least one medical patient to store medical history information in a computer database coupled to said network is not permitted until said at least one patient answer is provided, and further teaches analyzing the entered medical information; and, customizing additional inquiries regarding medical information based on the initial medical information entered (Schoenberg; col. 5, lines 40-50, and col. 6, lines 1-20).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Snowden with the demographic question/password security system of

Schoenberg. The motivation would have been to provide a system capable of definitively identifying both the correct patient information in the database as well as the identity of the requestor, based on demographic data inputs from the requestor. Further motivation would have been to provide a system capable of notifying the requestor that additional patient information is required to positively provide a patient match in the database (Schoenberg; col. 6, lines 1-25).

[C] As per claims 22, 23, and 31 Snowden, as applied to claims 1 and 24 above, teaches all limitations of claims 22, 23, and 31 except the following; Snowden does not specifically teach the patient stationed at the at least one first client computer (claim 22) or allowing the at least one medical patient to modify said medical history information from any computer connected to the network (claim 23). Further, Snowden does not teach allowing the at least one medical patient to view said medical history information from any computer connected to the network and, permitting the at least one medical patient to enter second specialty specific information relating to a second specialty area, wherein the medical history information does not have to be re-entered for the second specialty area (claim 31).

However, Schoenberg teaches allowing at least one medical patient stationed at the at least one first client computer to store medical history information in a computer database coupled to said network (Schoenberg; col. 4, lines 52-67 and FIG.2). Schoenberg also teaches allowing the at least one medical patient to modify or view said medical history information from any computer connected to the network (Schoenberg; col. 3, lines 45-52, and col. 7, lines 29-35 and Fig. 4). Further, Schoenberg teaches permitting the at least one medical patient to enter second specialty

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specific information relating to a second specialty area, wherein the medical history information does not have to be re-entered for the second specialty area (Schoenberg; col. 5, lines 1-20).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Snowden with the teachings of Schoenberg to provide the user with the ability to access the networked database system from any networked computer and further, to allow the patient to enter codes designating medical specialty and differential access to specialty related information or medical data. The motivation would have been to allow for the patient or other requestor to access server system from a setup computer/system or a requestor computer/system or any other computer or networked device provided the proper access codes and information were inputted by the requestor (Schoenberg; col. 3, lines 34-52). Further motivation would have been to allow the patient to designate different security levels and access to specialty related information such as serologic data, psychiatric data, cardiology data and genetic data (Schoenberg; col.5, lines 7-12).

[9] Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al., as applied to claim 1 above, in view of Wilkins (United States Patent # 6,523,009)

[A] As per claim 16, Snowden does not specifically teach the further step of permitting the at least one medical professional to add notes to said medical history information.

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However, Wilkins does teach the step of permitting the at least one medical professional to add notes to said medical history information (Wilkins; col. 4, lines 16-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Snowden with the physician note storage feature of Wilkins. The motivation would have been to enable the care providers to construct, write and record information in the individualized patient medical records (Wilkins; col. 4, lines 27-30).

[10] Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden as applied to claim 1 above, in view of Rao et al., (United States Patent Application Publication #2003/0130871).

[A] As per dependent claim 17, Snowden teaches at least one medical patient designating at least one medical professional or medical facility which may have access to said medical history information but does not teach a system that charges the medical professional or facility a fee.

However, Rao teaches charging the at least one medical professional or medical facility a fee for viewing said medical history information (Rao et al.; paragraphs [0016], [0017], [0018])

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Snowden with the fee structure of Rao. The motivation would have been to mine the patient medical data to determine if a patient meets criteria for specific

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clinical trials and then extract a fee from the party requesting information gained from the mined patient records/data (Rao et al.; [0038], [0049]).

[11] Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden, as applied to claim 1, in view of Sprenger et al., (United States Patent Application Publication #2003/0040946).

[A] As per dependent claim 21, Snowden does not specifically teach permitting the at least one patient to request a previously submitted username or password; and, transmitting the username or password to the at least one patient, if the at least one patient answers a challenge question correctly.

However, as is well known in the art, Sprenger et al., teaches permitting the at least one patient to request a previously submitted username or password; and, transmitting the username or password to the at least one patient, if the at least one patient answers a challenge question correctly (Sprenger et al.; [0274], [0275], [0276]).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Snowden with Sprenger in order to enable a patient to retrieve a forgotten password. The motivation would have been to enable a user who cannot remember a password to access the

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system by prompting the user to enter previously entered personal information such as the user's mother's maiden name (Sprenger et al.; [0275]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDR


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600